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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,745	11/20/2001	Yi Li	1488.0840002	9091

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EXAMINER

ULM, JOHN D

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 10/10/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/988,745

Applicant(s)
Li et al.

Examiner
John Ulm

Art Unit
1646



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 9, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-32 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4, 5 6) ☐ Other:

Art Unit: 1646

1) Claims 21 to 32 are pending in the instant application. Claims 1 to 20 have been canceled and claims 21 to 32 have been added as requested by Applicant in Paper Number 8, filed 08 August of 2003.

2) Applicant's traversal of the restriction requirement of Paper Number 7 has been considered but appears to be moot in light of Applicant's cancellation of all claims drawn to a non-elected invention. Further, the traversal is on the ground(s) that a search of the different inventions in a single application would pose no undue burden. This is not found persuasive because M.P.E.P. 803 states that:

“ For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That prima facie showing may be rebutted by appropriate showings or evidence by the applicant.”

Serious burden was shown in the original requirement by the separate classification and separate status in the art of the different inventions. Applicant has provided neither a showing or evidence to the contrary.

The requirement is still deemed proper and is therefore made FINAL.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3) Claims 21 to 32 are rejected under 35 U.S.C. § 101 because they are drawn to an invention with no apparent or disclosed specific and substantial credible utility. The instant

Art Unit: 1646

application has provided a description of an isolated DNA encoding a protein and the protein encoded thereby. The instant application does not disclose a specific biological role for this protein or its significance to a particular disease, disorder of physiological process which one would wish to manipulate for a desired clinical effect.

It is clear from the instant specification that the receptor protein described therein as a human amine receptor is what is termed an "orphan receptor" in the art. This is a protein whose cDNA has been isolated because of its similarity to known proteins but its native ligand or ligands have yet to be discovered. There is little doubt that, after complete characterization, this protein may be found to have a specific and substantial credible utility. This further characterization, however, is part of the act of invention and until it has been undertaken Applicant's claimed invention is incomplete. The instant situation is directly analogous to that which was addressed in *Brenner v. Manson*, 148 U.S.P.Q. 689 (Sus. Ct, 1966), in which a novel compound which was structurally analogous to other compounds which were known to possess anti-cancer activity was alleged to be potentially useful as an anti-tumor agent in the absence of evidence supporting this utility. The court expressed the opinion that all chemical compounds are "useful" to the chemical arts when this term is given its broadest interpretation. However, the court held that this broad interpretation was not the intended definition of "useful" as it appears in 35 U.S.C. § 101, which requires that an invention must have either an immediately obvious or fully disclosed "real world" utility. The court held that:

Art Unit: 1646

“The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility”, “ [u]nless and until a process is refined and developed to this point-where specific benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field”, and “a patent is not a hunting license”, “ [i]t is not a reward for the search, but compensation for its successful conclusion.”

The instant claims are drawn to a protein of as yet undetermined function or biological significance. Until some actual and specific significance can be attributed to the protein identified in the specification as a human amine receptor, or the gene encoding it, the instant invention is incomplete. The claimed protein is a compound known to be structurally analogous to proteins which are known in the art as G protein-coupled receptors. In the absence of a knowledge of the natural ligands or biological significance of this protein, there is no immediately obvious patentable use for it. To employ a protein of the instant invention in the identification of substances which inhibit or induce its activity is clearly to use it as the object of further research which has been determined by the courts to be a utility which, alone, does not support patentability. Since the instant specification does not disclose a credible "real world" use for the disclosed receptor protein then the claimed invention is incomplete and, therefore, does not meet the requirements of 35 U.S.C. § 101 as being useful.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to

Art Unit: 1646

make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3) Claims 21 to 32 are rejected under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to use the instant invention for those reasons given above with regard to the rejection of these claims under 35 U.S.C. § 101.

4) Claims 21, 25 to 30 and 32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make the claimed invention. These claims expressly require the deposited material recited therein.

Applicant, their assignee or their agent needs to provide a declaration containing the following:

The identification of the declarant.

A statement that a deposit has been made in a depository affording permanence of the deposit and ready accessibility thereto by the public if a patent is granted. The depository is to be identified by name and address.

A statement that the deposited material has been accorded a specific, recited, accession number.

A statement that the material has been deposited under conditions that assure that access to the material will be available during the pendency of the patent application to one determined by the Commissioner to be entitled thereto under 37 C.F.R. 1.14 and 35 U.S.C. § 122.

A statement that the deposited material will be maintained with all of the care necessary to keep it viable and uncontaminated for a period of at least five years after the most recent request for the furnishing of a sample of the deposited microorganism, and in any case, for a period of at least thirty years after the date of deposit or for the enforceable life of the patent, whichever period is longer.

Art Unit: 1646

A statement by declarant that all statement made therein of declarant's knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the instant patent application or any patent issuing thereon.

Alternately, it may be averred that deposited material has been accepted for deposit under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (e.g., see 961 OG 21, 1977) and that all restrictions on the availability to the public of the material so deposited will be irrevocably removed upon the granting of a patent. Additionally, the deposit must be referred to in the body of the specification and be identified by deposit (accession number) number, name and address of the depository, and the complete taxonomic description.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

35 U.S.C. § 120 states that:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

Art Unit: 1646


6) Claims 21 to 32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the Zeng et al. publication (BBRC 242:575-578, 26 Jan. 1998, cited by Applicant). Figure 1 on page 576 of Zeng et al. provided a written description of the claimed protein. Applicant is advised that the instant application can only receive benefit from an earlier application under 35 U.S.C. § 120 from an application which meets the requirements of 35 U.S.C. § 112, first paragraph, with respect to the now claimed invention. Because the instant application does not meet the requirements of 35 U.S.C. § 112, first paragraph, for those reasons given above and it is a continuation of application Serial Number 09/314,006, filed 19 May of 1999 as a divisional of application Serial Number 08/467,559, filed 06 June of 1995, the prior applications also do not meet those requirements and, therefore, is unavailable under 35 U.S.C. § 120.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



JOHN ULM
PRIMARY EXAMINER
GROUP 1800